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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,139	01/28/2004	Katsuhiko Yamazaki	248184US0	9716
22850	7590	01/25/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			KOSLOW, CAROL M	
			ART UNIT	PAPER NUMBER
			1755	
DATE MAILED: 01/25/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/765,139

Applicant(s)

YAMAZAKI ET AL.

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6 and 8-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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This action is in response to applicants' amendment of 28 November 2005. The newly filed oath is acceptable and has overcome the defective oath objection. The amendment to the specification has overcome the objection to the specification. The amendments to the claims have overcome the 35 USC 112 rejection, the obviousness-type double patenting rejection and the 35 USC 102(b) rejections. The provided translation of the priority document has overcome the 35 USC 102(e) rejections.

Claim 7 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2 June 2005.

This application contains claim 7 drawn to an invention nonelected without traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim 1 is objected to because of the following informalities: The amended definition of y is not as clear as the wording of the definition given in original claim 1. It is suggested to use the original wording. Appropriate correction is required.

Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

This claim teaches applying the paint to a substrate. This step does not further limit the process of making the paint since it is directed to the paint's intended use.

Claim 5 and 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the dispersion media". There is insufficient antecedent basis for this limitation in the claim or in claim 1. The claim 1 does not teach the use of a dispersion media in the main dispersion step. Claim 1 only teaches the use of a dispersion media in the preliminary dispersion step. Claim 10 as written is missing the relationship between the paint and a substrate. It is assumed applicants meant the paint is applied to a substrate. This applying step is a method of using the paint and thus is not an aspect in the production of the paint itself. Thus claim 10 is improperly dependent on claim 1.

Claims 1-3, 5, 6 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The process in the claims teach the dispersion media in the preliminary dispersion step have an average particle diameter  $y(\text{nm})$  which satisfying the relationship  $y \leq 0.01 x$ , where  $x$  is average maximum diameter  $x(\text{nm})$  of the magnetic powder. This is not taught by the originally filed disclosure or by the priority document and thus is new matter. The originally filed disclosure and the priority document teach the dispersion media in the main dispersion step have an average particle diameter  $y(\text{nm})$  which satisfying the relationship  $y \leq 0.01 x$ , where  $x$  is average maximum diameter  $x(\text{nm})$  of the magnetic powder and that the dispersion media in the

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preliminary dispersion step can be 0.8 mm in diameter (page 13 and examples). Except for the teachings on page 13 and the examples, the originally filed disclosure and the priority document are silent as to the diameter of the dispersion media in the preliminary dispersion step.

Claims 1-3, 5, 6, 8 and 9 would be allowable if rewritten or amended to overcome the objection and the rejections under 35 U.S.C. 112, set forth in this Office action.

There is no teaching or suggestion in the cited art of record of manufacturing magnetic paint comprising subjecting a concentrated magnetic paint to a preliminary dispersion step in the presence of a dispersion step to obtain a dispersed concentrated magnetic paint, the concentrated paint comprises at least one binder, at least one solvent, a magnetic powder, a dispersion agent and an abrasive; adding at least one solvent to the concentrated paint to obtain a dispersed magnetic paint and subjecting the dispersed magnetic paint to a main dispersion step and subsequently filtering the resulting dispersed paint to obtain a magnetic paint, where the dispersion media in the main dispersion step have an average particle diameter  $y(\text{nm})$  which satisfying the relationship  $y \leq 0.01 x$ , where  $x$  is average maximum diameter  $x(\text{nm})$  of the magnetic powder.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.


The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk  
January 20, 2006

  
C. Melissa Koslow  
Primary Examiner  
Tech. Center 1700